

REMARKS

Claims 1-13, 15-22, 28-29, 31-42, 44-49, 60-64, 66-67, and 76-77 were pending in the application. By this paper, Applicant amended Claims 1 and 28, and has cancelled Claims 67 and 76-77 without prejudice. Accordingly, Claims 1-13, 15-22, 28-29, 31-42, 44-49, 60-64, and 66 are presented for examination herein.

§102 Rejections

Per page 4 of the Office Action, Claims 76-77 each stand rejected under 35 U.S.C. 102(a) as being anticipated by Hendricks, et al. (U.S. Patent No. 6,463,585; hereinafter referred to as "Hendricks"). In response hereto, Applicant provides the following remarks.

**Claim 76-77**– Without addressing the merit or propriety of the rejection of this claims with respect to Hendricks, Applicant has by this paper canceled Claims 76-77 without prejudice, thereby rendering the §102 rejections thereof moot.

§103 Rejections

1. Per page 6 of the Office Action, Claims 1, 3, 4, 6-10, 13, 15-22, 29, 32-37, 40-42, 44-49, 60, 63-64, and 66-67 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks in view of Kinder, et al. (WO Patent Publication No. 2001/91474; hereinafter referred to as "Kinder"). In response hereto, Applicant provides the following remarks.

**Claim 1** – Without addressing the merit or propriety of the Office's rejection, and in an effort to expedite prosecution, Applicant has hereby amended Claim 1 to recite detecting an indicator indicative of an event *present within the signal* for the delivery of the programming content. Support for this amendment is replete through the Applicant's specification, and may be found specifically at, *inter alia*, page 6, lines 7 – 9 of Applicant's specification as filed.

Applicant respectfully submits that neither Hendricks nor Kinder, alone or in combination, teach or suggest the functionality of, in response to a detection of an indicator, generating a list of individual ones of the plurality of user terminals currently receiving the programming content, where the *indicator is present within the signal*.

Kinder does not in any way teach or suggest detecting an indicator indicative of an event present within the signal for the delivery of the programming content, and in response to the detection of the indicator, generating a list of individual ones of the plurality of user terminals currently receiving the programming content. Throughout the Office Action, it appears that the Office is asserting that the indicator in Kinder, which is sent from the set-top boxes as part of the feedback of active viewership of users, corresponds to the indicator of Claim 1 herein. However, the indicator in Kinder is not present within the programming content, but instead is sent as a response to viewed content (Kinder page 5, lines 1 – 3).

Hendricks is similarly deficient. The indicator discussed in Hendricks is generated at the cable headend as an indicator of a scheduled program break. (See Hendricks Col. 28, lines 9 – 14 and Col. 30, line 44 to Col. 31, line 11.) The program break indicator in Hendricks is not utilized for generating a list of the audience currently receiving the programming content.

Therefore, Applicant respectfully submits Hendricks and/or Kinder do not teach or suggest the limitations of Claim 1 as amended herein.

**Claim 9** – Applicant respectfully traverses the Office’s §103 rejection of Claim 9 as being unpatentable over Hendricks in view of Kinder.

Applicant notes that “*To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.*” *In re Royka*, 490 F.2d 981 (CCPA 1974). See MPEP 2143.03.

On page 10 of the Office Action, the Office states that it would have been obvious to one skilled in the art to modify Hendricks with the teaching of Kindler to teach “*in response to a detection of an indicator, identifying a set of user terminals currently receiving the program stream*”. Applicant disagrees.

Kinder teaches monitoring feedback from set-top boxes in order to track the content viewership of currently active viewers. “*The selector may use this information to automatically and dynamically modify pre-established demographic profile assumptions*” (see Kinder page 5, lines 1 – 3). Kinder does not teach or suggest the use of indicators in the program stream to trigger the identification of a set of user terminals, but rather the invention of Kinder identifies user terminals in response to monitoring feedback indicating a change in viewership habits.

Hendricks teaches a targeted advertising system that implements a predetermined switching plan to alternate between feeder channels upon the detection of advertisement break in the program stream. *"After the set top terminal 220 receives and stores the switching plan, the set top terminal 220 will tune to the appropriate feeder channel during the corresponding program break"* (See Hendricks at Col. 28, lines 9 – 12). Therefore, the program break indicator of Hendricks is the means to implement switching plans, and to notify the set top box when to implement a switching plan, and respectfully is not used by the cable head end as a trigger to identify user terminals.

Thus, neither Hendricks nor Kinder, whether taken alone or in combination, teaches or suggests in response to detection in the program stream of an indicator, identifying a set of user terminals currently receiving the program stream.

Therefore, Claim 9 distinguishes over the art of record, and is not rendered unpatentable given these references.

**Claim 36** – Applicant respectfully traverses the Office's §103 rejection of Claim 36 as being unpatentable over Hendricks in view of Kinder.

On page 13 of the Office Action, the Office states that Hendricks discloses *"a spot placement engine for determining which advertisements should occupy the pods during the broadcast programs based on the received information (col. 31, ll. 33-41) which meets "a processing unit responsive to a detection of the message, responsive to a detection of the indicator, generating at least one programming segment")"*.

Even if *arguendo* the Office's statement is correct, Claim 36 does not recite the generation of one or more data streams (containing one or more alternate programming segments for substituting the scheduled programming segment within the program stream) being in response to a detection of a message and/or a detection of the indicator. Rather, Claim 36 recites that in response to the detection of a message, a set of one or more user terminals which is currently receiving the program stream are identified.

Furthermore, the Office at page 14 of the Office Action, specifically indicates that *"Hendricks is silent on a processing unit responsive to a detection of the message, for identifying a set of one or more user terminals which is currently receiving the program stream."*

Furthermore, at page 14 of the Office Action, the Office asserts that Kinder discloses “a processing unit, for identifying a set of one or more user terminals which is currently receiving the program stream generating a list of an audience currently receiving the programming content (page 5, ll. 1-3, 9-11 & figure 3, label 40 (the selector uses the feedback tags to modify demographic mapping)).” Applicant submits, however, that even if the Office’s assertion is correct (a point which Applicant does not necessarily concede), nowhere does Kinder disclose the identification and/or generation being responsive to the detection of the message in the program stream. Instead, in Kinder, identification and/or generation is responsive to a change in viewership determined by feedback received from the set top boxes (Kinder page 5, lines 1 – 3). There is, respectfully, a salient difference between (i) merely identifying a set of user terminals (as is performed in Kinder), and (ii) identifying the terminals in response to the detection of a message (as recited in Claim 36).

Also, per page 13 of the Office Action, the Office asserts that Hendricks discloses “grouping said identified set of one or more terminals into one or more groups based on at least one characteristic...(figure 4c, label 309, col. 26, ll. 60-63 & col. 27, ll. 1-6)”. Although Hendricks discloses grouping terminals into one or more groups based on at least one characteristic (see e.g., col. 5, lines 1-13), Hendricks does not in any way that Applicant can see teach or suggest grouping an identified set of terminals which are currently receiving the program stream, as is recited in Claim 36. The groups are determined, in Hendricks, prior to any content delivery; thus, the groups are not comprised of an identified set of terminals which are currently receiving the program stream.

Kinder does not remedy this deficiency, as feedback from the set top boxes, not a detection of message in the program stream, is responsible for grouping sets of terminals.

At page 13 of the Office Action, the Office further asserts that Hendricks discloses “grouping said identified set of one or more terminals into one or more groups based on at least one characteristic, the at least one characteristic comprising a function of at least the number of available transmission channels in the network (figure 4c, label 309, col. 26, ll. 60-63 & col. 27, ll. 1-6)”. {emphasis Examiner’s} Applicant respectfully disagrees.

At e.g., col. 26, line 60 – col. 27, line 6, Hendricks merely discloses various criteria for segmenting the user terminals into groups. Hendricks discloses various examples of target criteria including for example, “demographic targeting (age/sex/income) and Area of Dominant

*Influence (ADI).*” However, nowhere does Hendricks disclose grouping as a function of at least the number of available transmission channels, as is explicitly recited in Claim 36.

Kinder does not remedy this deficiency, as Kinder organizes groups based on active viewership and location.

Based on the foregoing, several of the limitations of Claim 36 are not taught or suggested by Hendricks and/or Kinder. Thus, Claim 36 is not rendered obvious thereby.

**Claim 60** – Applicant respectfully traverses the Office’s §103 rejection of Claim 60 as being unpatentable over Hendricks in view of Kinder.

Applicant submits that neither Hendricks nor Kinder, taken alone or in combination, teaches or suggests “*a processing unit responsive to a detection of the indicator, for generating a list of an audience receiving the programmed content...*” as recited in Claim 60. Hendricks teaches using program breaks to plan the scheduling of advertisements in feeder channels, and to direct set top boxes to implement preloaded switching plans to tune to the different feeder channels. The invention of Hendricks does not use the program breaks for generating a list of an audience receiving the programmed content.

Kinder does not remedy this deficiency. Kinder teaches monitoring active viewership of users by monitoring feedback from set top boxes. The feedback from the set top boxes is used to dynamically change content delivery to users (See Kinder page 3, line 29 to page 4, line 3).

Therefore, neither Hendricks nor Kinder teaches or suggest the use of detecting indicators of advertising segments to generate a list of an audience receiving the programming content.

**Claims 3, 4, 6-8, 10, 15-22, 29, 32-35, 37, 40-42, 44-49, 63-64, and 66-67** – Applicant respectfully submits that the §103 rejection of dependent Claims 3, 4, 6 – 8, 10, 15 – 22, 29, 32 – 35, 37, 40 – 42, 44 – 49, 63 – 64, and 66 are rendered moot, given the arguments and amendments discussed above with respect to independent Claims 1, 9, 36, and 60 as applicable.

**Claim 67** - Without addressing the merit or propriety of the Examiner’s rejection of this Claim with respect to Hendricks and Kinder, Applicant has by this paper cancelled Claim 67 without prejudice, thereby rendering the §103 rejections thereof moot.

2. Per page 16 of the Office Action, Claim 28 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks in view of Kinder, in view of Brooks (US Patent Publication No. 2003/0056217; hereinafter referred to as "Brooks"). In response hereto, Applicant provides the following remarks.

5 **Claim 28** – By this paper, Applicant has amended Claim 28 to recite a detector for detecting an indicator present in the programming content. Support for this amendment may be found, *inter alia*, page 6, lines 7 – 9 of Applicant's specification as filed.

10 Kinder does not in any way teach or suggest generating the list of the audience currently receiving the programming content in response to a detection of an indicator present in the programming content, as is now recited in Claim 28. The element in Kinder which it appears that the Office is asserting to correspond to the "indicator" of Claim 28 is being sent from the set-top boxes as part of the feedback of active viewership of users. This indicator is not present within the programming content, but instead is sent as a *response* viewed content. In this regard, 15 Applicant submits that Kinder could even be considered to teach away from the invention of Claim 28 as amended, since one of ordinary skill would be led away from placing the indicator in the programming content when delivered after reading Kinder. See MPEP 2141.02.

20 Additionally, the element in Hendricks which it appears that the Office is asserting to correspond to the "indicator" of Claim 28 is generated at the cable headend (as an indicator of a scheduled program break), and which is used for scheduling advertisements on feeder channels and implementing predetermined switching plans on set top boxes. (See Hendricks Col. 28, lines 9 – 14 and Col. 30, line 44 to Col. 31, line 11.) The Hendricks indicator is not utilized for generating a list of the audience currently receiving the programming content.

Brooks is similarly deficient.

25 Thus, neither Hendricks nor Kinder nor Brooks, alone or in combination teaches or suggests generating a list in response to detecting an indicator present in the programming content.

Therefore, Claim 28 as amended herein distinguishes over the cited art, and is not rendered obvious thereby.

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3. Per page 19 of the Office Action, Claims 2, 11, 29, 38, and 61 each stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks, in view of Kinder, in view of Kanjoia et al. (U.S. Patent No. 7,237,250)

Applicant respectfully submits that the §103 rejection of dependent Claims 2, 11, 29, 38, and 61 are rendered moot, given the arguments and amendments discussed above with respect to independent Claims 1, 9, 28, 36, and 60.

*Other Remarks*

Applicant hereby specifically reserves all rights of appeal (including those under the Pre-Appeal Brief Program), as well as the right to prosecute claims of different scope in another continuation or divisional application.

Applicant notes that any claim cancellations or additions made herein are made solely for the purposes of more clearly and particularly describing and claiming the invention, and not for purposes of overcoming art or for patentability. The Office should infer no (i) adoption of a position with respect to patentability, (ii) change in the Applicant's position with respect to any claim or subject matter of the invention, or (iii) acquiescence in any way to any position taken by the Office, based on such cancellations or additions.

Furthermore, any remarks made with respect to a given claim or claims are limited solely to such claim or claims.

If the Examiner has any questions or comments which may be resolved over the telephone, he is requested to call the undersigned at (858) 675-1670.

Respectfully submitted,

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